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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/478,796 01/07/00 CHAGANTI

N PSCO-005

 EXAMINER

WM31/0523

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BARRON JR, G	
ART UNIT	PAPER NUMBER

2132  
DATE MAILED:

05/23/01

*20*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/478,796	CHAGANTI ET AL.	
Examiner	Art Unit		
Gilberto Barrón Jr.	2132		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 13 November 2000 and 21 February 2001 .

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-5 and 7-30 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-5 and 7-30 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

15) Notice of References Cited (PTO-892)                    18) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11,13,15 .                    20) Other: \_\_\_\_\_ .

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 13, 2000 has been entered.

***Election/Restrictions***

2. Claims 31-43 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions Groups II, III and IV, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 19.

3. In addition, nonelected claims 31-43 have been canceled in Paper No. 19.

***Response to Amendment***

4. The response filed on November 13, 2000, has been carefully considered, but is not persuasive in overcoming the rejections presented in the Final Office Action dated August 1, 2000. Further, newly discovered prior art has necessitated new grounds of rejection, which are presented below. The statement of the grounds of rejection followed by a response to Applicant's arguments appears below.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 101***

6. Claims 26-30 are rejected under 35 U.S.C. 101 because the claimed invention is inoperative and therefore lacks utility. The instant claims have been amended and now recite "program of instructions to..." which is inoperative as program of instructions, in themselves, cannot provide any functionality. Programs of instructions when executed by a computer are operative to perform the function recited.

***Claim Rejections - 35 USC § 112***

7. Claims 1-5 and 7-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The instant claims are indefinite because the method steps recited in the claims are in "steps plus function" form which invoke 35 U.S.C. 112, sixth paragraph, but applicant has failed to provide a description or indicate where support in the specification is to be found, of the corresponding acts, or the equivalents thereof, to allow determination of the scope of the claims.

8. Claims 1-5 and 7-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The instant claims recite method steps which are in "step plus function" form, which invoke 35 U.S.C. 112, sixth paragraph, but there is no indication of where support for the corresponding acts, or equivalents

thereof, are to be found in the specification. Applicant is required to point out where support for the "step plus functions" acts is to be found.

***Claim Rejections - 35 USC § 103***

9. Claims 1-5, 14-16, 19-21 and 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perry et al. (5,241,466) in view of Smith (4,956,769).

The Perry patent discloses a central depository for central information such as living will and other associated information. The Perry patent discloses establishing an account for the user with a server computer; see Fig. 1, computer 10 and col. 3, lines 46-64. The method of claim 1 and 25 is disclosed by the Perry patent as follows. The step of assigning an identifier is disclosed at col. 5, line 2. The step of entering personal information is disclosed at col. 4, lines 50-68. The step of storing in the database the customer file is disclosed at col. 4, lines 10-18 and 67-68. The step of receiving a request message from a requester is disclosed at column 8, lines 36-44. The step of retrieving from the database the information is disclosed at col. 8, lines 58-66. The step of securely transmitting the information is disclosed at col. 8, line 67 thru col. 9, line 7.

However, the Perry patent does not disclose the step in claim 1 of assigning a security level to each information object nor the claim 4 step of designating the requester as a junk requester if a predetermined number of requests are not authorized.

The patent to Smith teaches a security protection system for a computer database wherein users are given security profiles and the data is stored with data fields for limiting the access to users of the information stored therein, see col. 1, line 58

thru col. 2, line 10. The Smith patent also teaches a protection step of generating an alarm if a predetermined number of unauthorized requests are detected; see col. 6, lines 1-34.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the security system of the personal information database disclosed in Perry by providing for assigning a security level to the information object and generating an alarm if a predetermined number of unauthorized attempts are made as taught in Smith in order to provide a computerized database with the security against users attempting fraud. See Smith at col. 1, lines 24-47.

Claims 2 and 27, the step of requester authorization and verification is disclosed at col. 8, lines 45-52 of Perry.

Claims 3, the step of requester not authorized and rejected is disclosed at col. 8, lines 54-57 of Perry.

Claims 5 and 28-30, the step of recording every access to a user's information is disclosed at col. 7, lines 36-38 of Perry.

Claims 14 and 15 are met by Perry at col. 2, lines 55-57 and col. 6, line 68 thru col. 8, line 35 which disclose updating to meet the recitation of altering the user's personal information.

Claim 16, Perry teaches a computerized database to meet the recitation of a communication network.

Claim 19, Perry discloses personal information to meet the recitation of the particular types of information recited herein.

Claims 20 and 21, Perry discloses receiving an authorization request from the requester and verifying the request at col. 2, lines 43-54.

Claim 24, Perry discloses a periodic status report at col. 7, lines 1-4.

Claim 26, Smith discloses using plural security clearance levels such as user ID as a first security clearance level and terminal location as a second security clearance level. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the access procedure in Perry to provide for plural levels of security clearances which must be cleared by a requester as taught in Smith in order to secure the computerized database against attempted fraud, see Smith at col. 1, lines 24-47.

10. Claims 7-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perry in view of Smith as applied to claim 1 above, and further in view of Murphy (5,644,711).

Claim 7 provides for generating an authorization key, while the Perry patent discloses identifying particular authorized users. The Murphy patent teaches secure access to selected directories using user ID and a password, see col. 4, lines 14-38. The teaching of a password implies that an authorizing key is generated by the method. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide for authorization keys such as passwords as taught in Murphy for the select access to particular objects as taught in both Perry and Murphy in order to provide a security measure for access to select portions of a database, see col. 6, lines 15-24 of Murphy.

Claims 8-13 are disclosed in Perry as the particular information requested is checked to see if the particular requester is authorized access to the information, see col. 8, lines 45-57. Further, Smith teaches that particular requester characteristics or attributes such as terminal location and type of information requested are part of the information request.

11. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perry in view of Smith as applied to claims 1 and 16 above, and further in view of the Moozakis article entitled "Internet Printing Takes Hold".

The Perry reference does not disclose using the Internet Printing Protocol for transmitting information.

The article entitled "Internet Printing Takes Hold" describes IPP as a mechanism for transmission of information directly to a printer for distribution of information.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit the requested information in Perry under the Internet Printing Protocol as Perry discloses transmission of the information over a network, see col. 9, lines 1-7 and the article by Moozakis teaches information distribution by Internet Printing Protocol is an efficient manner for distributing information.

12. Claims 18 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perry in view of Smith as applied to claim 1 above, and further in view of Vaudreuil (5,621,727).

The Perry reference does not disclose the secure e-mail or the executable query requests of the instant claims.

Vaudreuil teaches a network that transmits information securely using PEM or public key, see col. 28, lines 23-48 and also teaches a network that allows requests for information to be in a form executable for database searching, see col. 9, lines 20-25.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to secure the transmission of the requested information disclosed in Perry by means such as PEM or public key as taught in Vaudreuil in order to secure the information from other parties and to send requests for information in a executable form such as SQL as taught in Vaudreuil in order to provide for searching of a database by automated means.

#### ***Response to Arguments***

13. Applicant's arguments filed with the Amendment of November 13, 2000 have been fully considered but they are not persuasive. In particular, the phrase "assigning at least one of a plurality of security levels to each information object" is taught in the Smith patent. Each information object in Smith (defined by a data record or data field) is assigned "at least one of a plurality of security levels". Col. 4, lines 36-38 defines how each information object is defined within a global database of information objects. Col. 4, lines 49-50 teaches assigning for each object (data record or data field) a security level to meet the additional functional limitation of "thereby enabling access to individually selected portions of the user's personal information by individual receiving parties." There are a plurality of security levels in view of the fact that there are a plurality of access conditions based on a plurality of conditions such as user ID, terminal location and the particular data record or data field. There is "at least one" security level

assigned to each data object and in response to a request for information from a receiving party there is a selected portion that could be transmitted to the requesting party.

14. Applicant's assertion that no *prima facie* case has been established in not persuasive as the statement of the grounds of rejection clearly indicate where the Perry and Smith references (and the further secondary references of Murphy and Moozakis) provide the suggestions and/or reasons for combining their teachings. Each reference has a clear indication of where the asserted teaching is to be found. (Note: Level of skill in the art in *ex parte* proceedings are usually determined with respect to the prior art references cited. The given level of skill in this particular case may be shown with respect to the environment and problems addressed by the Perry, Smith, Murphy and Moozakis references.)

15. Applicant's assertions regarding secondary considerations are not persuasive as Perry teaches the need to address protection of personal information and Smith teaches how to protect various portions of information using selected levels of protection.

16. Applicant's argument that there was not indication of the reason for combining is not persuasive as column 8, lines 45-57 of Perry, (as noted in the Office Action of August 11, 2000) teaches the processing for requests of information and the proper requirement for authorization of the information.

***Claim Rejections - 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

18. Claims 1-5 and 7-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Rozen et al (6,073,106).

The Rozen patent discloses a method of managing and controlling access to personal information. Column 4, lines 33-65 describe a service provider that allows a user to establish an account, store personal information, assign different security levels for each category or portion of information, receiving requests for the information including first party identifier, and in response, selecting a first portion of the first parties personal information that could be transmitted to a receiving party. The disclosure of Rozen also teaches using PINs to meet the requirements for an authorization key for the requested portions of personal information.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gilberto Barrón Jr. whose telephone number is (703) 305-1830. The examiner can normally be reached on Mondays thru Thursdays from 8:00 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Tod Swann, can be reached on (703) 308-7791. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-0040.

Art Unit: 2132

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

*Gilberto Barrón*  
GILBERTO BARRÓN, JR.  
PRIMARY EXAMINER  
ART UNIT 2132